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OFFICE OF PETITIONS

In re Application of :
Seungkoo Kang et al. :
Application No. 10/695,060 : DECISION ON PETITION UNDER
Filing Date: October 28, 2003 : 37 C.F.R. §1.53
Attorney Docket No. 5003073- :
033US1 :
Title: SUPERABSORBENT POLYMER :

This is a decision on the petition under 37 C.F.R. §1.53(e), filed October 26, 2004, requesting that the above-identified application be accorded a filing date of October 28, 2003, with Figures 1-2 as part of the original disclosure of the application.

The application was deposited on October 28, 2003. However, on February 5, 2004, the Office of Initial Patent Examination (OIPE) mailed a "Notice of Incomplete Nonprovisional Application - Filing Date Not Granted" (notice) stating that the application had not been accorded a filing date, and that a filing date would be accorded upon the deposit of drawings. The notice further indicated that the oath or declaration was not executed. The notice set a two-month period for response.

On April 5, 2004, Figures 1-2 were deposited, along with an executed declaration and the surcharge associated with the late submission of the same. On October 26, 2004, the instant petition was filed, along with the petition fee. On December 15, 2004, a petition to expedite was filed.

Petitioner does not indicate whether the drawings were inadvertently omitted upon filing. Nevertheless he has requested that the Office grant a filing date of October 28, 2003 to the above-identified application.

It is noted that claims 30-31 of the present application are directed towards a process. MPEP §608.02 states, in part:

An OIPE formality examiner should not treat an application without drawings as incomplete if drawings are not required. A drawing is not required for a filing date under 35 U.S.C. 111 and 113 if the application contains:

- (A) at least one process claim including the term "process" or "method" in its introductory phrase;
- (B) at least one composition claim including the term "composition," "compound," "mixture" or "pharmaceutical" in its introductory phrase;
- (C) at least one claim directed to a coated article or product or to an article or product made from a particular material or composition (i.e., an article of known and conventional character (e.g., a table), coated with or made of a particular composition (e.g., a specified polymer such as polyvinyl-chloride));
- (D) at least one claim directed to a laminated article or product (i.e., a laminated article of known and conventional character (e.g., a table)); or
- (E) at least one claim directed to an article, apparatus, or system where the sole distinguishing feature is the presence of a particular material (e.g., a hydraulic system using a particular hydraulic fluid, or a conventional packaged suture using a particular material).

For a more complete explanation about when a drawing is required, see MPEP 601.01(f). For applications submitted without all of the drawings described in the specification, see MPEP § 601.01(g). If an examiner determines that a filing date should not have been granted in an application because it does not contain drawings, the matter should be brought to the attention of the supervisory patent examiner (SPE) for review. If the SPE decides that drawings are required to understand the subject matter of the invention, the SPE should return the application to OIPE with a typed, signed, and dated memorandum requesting cancellation of the filing date and identifying the subject matter required to be illustrated.

Pursuant to this section of the MPEP, it has been PTO practice to treat an application that contains at least one compound, composition, process, or method claim as an application for which a drawing is not necessary for an understanding of the invention under the first sentence of 35 U.S.C. §113. A review of the record reveals that the claims contain process claims. Therefore, the present application is deemed to be an application which does not require a drawing for an understanding of the invention. Accordingly, the application, as originally filed, is entitled to a filing date of October 28, 2003.

The petition is **GRANTED-IN-PART**.

The notice mailed on February 5, 2004 was sent in error, and is hereby **VACATED**. As such, no petition fee is necessary, and the petition fee has not been charged to Petitioner's Deposit Account.

On April 5, 2004, Petitioner submitted figures 1-2. If petitioner desires for the Examiner to consider these missing pages which were not submitted as part of the original disclosure, then Petitioner may submit these pages as a Preliminary Amendment. The Preliminary Amendment should be filed before first action on the merits. Any such amendment will, of course, be reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

The application file is being returned to the Office of Initial Patent Examination for further processing with a filing date of October 28, 2003, using only the application papers filed on that date.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



Paul Shaneski
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Office of Petitions
United States Patent and Trademark Office

¹ See MPEP 608.02(h) and 608.04.